

REMARKS

This Amendment is respectfully submitted in response to the Office Action rendered in the above-identified patent application on May 25, 2004. It is timely submitted in view of the Petition for Extension of Time submitted concurrently herewith.

The Office Action of May 25, 2004 notes that claims 23-52 were cancelled on 06 February 2003 in an interview with applicants' attorney. Applicants respectfully submit that this was inadvertently reflected as these claims having been "withdrawn". This has been corrected in the Listing of the Claims at page 4 of this response. Applicants respectfully note that this was performed without prejudice and that they have the right to re-present these claims at an appropriate time.

Applicants gratefully acknowledge the withdrawal of the rejection of claim 1 under 35 U.S.C. 112, second paragraph.

The Office Action of May 25, 2004 again rejected claims 1-3, 6, 7, 9, 15 and 19 under 35 U.S.C. 102(e) as being anticipated by Costanzo (US Patent No. 6,323,219). Applicants respectfully request reconsideration of this rejection in view of the foregoing amendments to the claims and the ensuing discussion.

As stated in their Amendment of February 12, 2004, Applicants respectfully submit that nowhere does Costanzo suggest or describe methods to use the compositions of applicants' invention to affect hair. The Office Action of May 25, 2004 suggests that the method of applicants' invention is inherent in Costanzo's topical application of a topically active composition "that comprises one or more compounds derived from one or more of the botanical families." [Office Action, 5/25/2004, p. 3].

As set forth in the claims, however, applicants make clear that according to applicants' methods, the composition is to be applied to **mammalian hair in need of a change in appearance**. There is only one reference in Costanzo to "hair", as follows:

...**In an example related to skin disorders**, gray hair is treated with melanin (plain or liposome-delivered) and phagocytosis-increasing agent (e.g., SLIGRL), ideally in a shampoo or cream. [Col. 30, l. 22-26] (emphasis added)

As set forth above, this specifically cites using a phagocytosis-increasing agent to darken gray hair in connection with a **skin disorder**. Costanzo, immediately preceding this statement, in the

same paragraph, defines skin disorders as follows: "Skin disorders include unwanted pigmentation, unwanted depigmentation, psoriasis...In one specific example, vitiligo patients are treated with melanin...together with a phagocytosis-increasing agent...to lighten the dark spots" [Col. 30, l. 15-20]). Costanzo nowhere indicates that the topical compositions set forth therein should be applied to skin or hair in order to change its appearance or in such a way as to effect a delay in hair growth or facilitating removal of hair, reducing hair visibility or improving hair style or hair management. In fact, one would not expect an individual to apply melanin and a phagocytosis-increasing agent to darken hair that one would want removed. Thus, Costanzo would not teach one of ordinary skill in the art to use compositions set forth therein in such a way that he or she would inherently practice the methods of applicants' invention. In light of the foregoing, Applicants respectfully suggest that the claimed methods are not anticipated by Costanzo and respectfully request reconsideration of the rejection under 35 U.S.C. 102(e).

The Office Action of May 25, 2004 further reiterated the rejection of claims 4, 5, 8, 10-14, 16-18 and 20-22 under 35 U.S.C. 103(a) as being unpatentable over Costanzo in view of JP 9059166A. Applicants respectfully request reconsideration of this rejection in view of the ensuing discussion.

As set forth above, there is no suggestion or teaching in Costanzo to apply the compositions therein to effect changes in the hair's appearance. Furthermore, there is no teaching in Costanzo that would motivate one to combine the teachings therein with JP 9059166. Although Costanzo mentions applying soy-derived compositions to the skin, Costanzo states that the active ingredient therein are "compounds that inhibit trypsin, such as serine protease inhibitors, and in particular, soybean trypsin inhibitor..." [Costanzo, col. 8, l. 44-46]. Costanzo does not cite isoflavones as participating in the methods described therein. The mere presence of isoflavones in soy would not necessarily guide one of ordinary skill in the art toward combining the teachings of Costanzo with the teachings of JP 9059166A.

Furthermore, applicants respectfully submit that JP 9059166A teaches **away** from the methods and compositions of applicants' invention. As set forth in JP 9059166A, the benefits of a specific type of isoflavone, "malonyl isoflavone glycoside" are quite different from those of the methods of applicants' invention. Specifically, JP 9059166A suggests that this type of isoflavone **stimulates hair growth**:

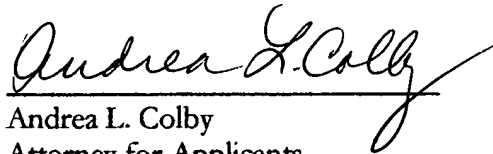
Epithelial cell growth promoter useful as dermal agent comprises malonyl isoflavone glycoside prepd. from soybean or aq. extract of soybean as the active ingredient...The growth promoter is useful as a skin cosmetic, **stimulator of hair growth**, anti-inflammatory agent, for preventing skin ageing, skin smoothing and for wound healing. [JP 9059166A, abstract] (emphasis added)

In contrast, the methods of applicants' invention relating to "effecting changes in mammalian hair appearance and hair pigmentation, and **reducing hair growth**, and hair follicle and hair shaft size" are quite unexpected in light of JP 9059166A. Furthermore, nowhere does JP 9059166A mention changes in mammalian hair appearance, hair pigmentation, or hair follicle and hair shaft size. Thus, applicants respectfully submit that one of ordinary skill in the art would not be motivated to combine the teachings of Costanzo, which does not mention hair treatment at all, with JP 9059166A, which merely discusses utilizing a specific type of isoflavone for stimulating hair growth. Applicants respectfully contend that one of ordinary skill in the art would not have been led to the methods and compositions of their invention by the teachings of Costanzo and JP 9059166A, taken separately or together and therefore respectfully request reconsideration of the rejection under 35 U.S.C. 103(a).

Applicants respectfully submit, concurrently herewith, a Supplemental Information Disclosure Statement.

Based upon the foregoing discussion and amendments to the application, applicants respectfully request reconsideration of the foregoing rejections. An early allowance is earnestly solicited.

Respectfully submitted,



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